

## REMARKS

Applicants have reviewed and considered the non-final Office Action mailed on April 7, 2008. Claims 1-46 are currently pending in the application, of which claims 1-18 and 28-45 currently stand rejected. Claims 19-27 have been previously withdrawn. Claim 46 has been withdrawn by the Examiner in the Office Action dated April 7, 2008. Applicants respectfully request reconsideration and allowance of claims 1-18 and 28-46 in view of the following remarks.

### *Claim Rejections - 35 U.S.C. § 112*

The Examiner rejects claims 28-45 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse this rejection.

The fundamental factual inquiry under the written description requirement is “whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.” MPEP 2163.02. Also, “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” MPEP 2163.02.

In the case at hand, the Examiner rejects the negative limitation of “oak dust that does not consist of natural cork.” In *Ex parte Parks*, 30 U.S.P.Q.2d 1234 (Bd.Pat.App. & Interf 1994 (released)), the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences (hereinafter “Board”) addressed whether a claim that included a negative limitation was properly supported under the written description requirement of 35 U.S.C. § 112, first paragraph. In holding that the negative limitation “in the absence of a catalyst” was properly supported, the Board stated that “it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed.” *Parks*, 30 U.S.P.Q.2d at 1236. In particular, the Board stated that “it cannot be said that the originally-filed disclosure would not have conveyed to one having ordinary skill in the art that appellants had possession of the concept of conducting the decomposition step generating nitric acid in the absence of a catalyst.” *Id* (emphasis in original).

The specification provides ample support for the concept that natural cork be excluded from oak dust. For example, the specification discloses that “[o]ak dust is sometimes used by wineries to enhance the flavor or wine.” Specification, paragraph 25. The Tiberia declaration dated March 30, 2006, which clarifies that oak dust used by wineries does not include natural cork, states that “the addition of natural cork as an ingredient of a wine could be detrimental since natural cork could introduce trichloroanisol (TCA) to the wine, causing the wine to develop a musty taste and smell.” Tiberia declaration, section 7. Thus, the specification conveys to one of ordinary skill in the art the concept that oak dust does not include natural cork. To further corroborate this fact, the Tiberia declaration also states that “it is well known in the wine making industry that oak dust is not manufactured or otherwise prepared from the cork oak tree or from natural cork.” Tiberia declaration, section 6.

The specification also states that the oak dust used in the compound of Applicants’ claimed invention may be obtained from World Cooperage, a winery supply house. Specification, paragraph 25. A visit to the website of World Cooperage at [www.worldcooperage.com](http://www.worldcooperage.com) reveals that oak dust sold by the company (information contained at [www.oaksolutionsgroup.com](http://www.oaksolutionsgroup.com)) does not include ground or powdered natural cork. Information from these web sites were included with the Response to Office Action dated August 2, 2007. Again, the specification conveys to one of ordinary skill in the art the concept that oak dust does not include natural cork.

The Examiner asserts that “[t]he concept of ‘oak dust that does not consist of natural cork’ which is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure.” Office Action dated April 7, 2008, page 4, emphasis added. However, the Examiner cannot use an alleged lack of enablement of the claim at issue to reject the claim under the written description requirement because “[t]he written description requirement is separate and distinct from the enablement requirement.” MPEP 2161. In particular, “[a]n invention may be described without the disclosure being enabling.” MPEP 2161. Thus, the Examiner’s statement regarding enablement does not provide proper support for the written description rejection.

The Examiner also improperly states that “Applicants cannot rely on the Declaration of Tiberia to provide support or assumed from applicants’ arguments [sic].” Office Action dated

April 7, 2008, page 4. However, the Tiberia declaration demonstrates the knowledge of one of ordinary skill in the art with respect to a written description requirement analysis. Also, in *Ex parte Parks*, the Board used two declarations to determine whether the originally-filed disclosure conveyed to one of ordinary skill in the art the concept related to the negative limitation at issue in that case. See, *Parks*, 30 U.S.P.Q.2d at 1236-7. Applicants respectfully request that the rejection of claims 28-45 under 35 U.S.C. § 112 be withdrawn.

### ***Claim Rejections - 35 U.S.C. § 103***

The Examiner has rejected claims 1-18 and 28-45 under 35 U.S.C. 103(a) as obvious over Oka et al. (WO 03/020817), Meguriya I (U.S. Patent No. 5,981,610), or Meguriya II (U.S. Patent No. 6,506,331), each, taken in view of Dewar (U.S. Patent No. 6,022,816), and further in view of Descamps et al. (U.S. Patent No. 5,162,397), Strauss (U.S. Patent No. 4,031,059), and Snogren (U.S. Patent No. 3,296,153) all taken together.

### **References Do Not Teach or Suggest All of the Claimed Limitations**

An applicant's claimed invention may be unpatentable under 35 U.S.C. § 103 only if it would have been "obvious" to a person of ordinary skill in the art to modify or combine the prior art in order to meet the claims, even if a single reference does not anticipate the claimed invention. See, 35 U.S.C.A. § 103(a) (West, WESTLAW through P.L. 110-36 approved 06-15-07); *Beckson Marine v. Nfm, Inc.*, 292 F.3d 718, 727 (Fed. Cir. 2002) (stating that "obviousness may render a claimed invention invalid where the record contains a suggestion or motivation to modify the prior art teaching to obtain the claimed invention," even if the prior art does not "reach expressly each limitation exactly"); *Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108 (Fed. Cir. 1987) ("the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed"). "Obviousness" is a legal conclusion based on underlying findings of fact. *In re Peterson*, 315 F.3d 1325, 1328 (Fed. Cir. 2003). The underlying factual inquiry includes determining "the scope and content of the prior art;" ascertaining the "differences between the prior art and the claims at issue;" and resolving "the level of ordinary skill in the pertinent art." *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966); *In re Zurko*, 258 F.3d 1379, 1383-84 (Fed. Cir. 2001).

The Examiner, though, carries the initial burden of establishing a *prima facie* case of obviousness before rejecting a claimed invention under 35 U.S.C. § 103. *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *In re Alton*, 76 F.3d at 1175; *In re Oetiker*, 977 F.2d at 1445; *In re Wertheim*, 541 F.2d at 263 & 265; United States Patent & Trademark Office, MPEP §§ 2141, 2142, 706.020) (8th ed, rev. 5, 2006); *see also* 35 U.S.C.A. § 132. To establish *prima facie* obviousness of a claimed invention, the Examiner must demonstrate with substantial evidence that all the claim limitations are taught or suggested by the prior art. *See, e.g., In re Zurko*, 258 F.3d at 1384-85 (holding invention was not obviousness because prior art failed to teach single element); *In re Grassell*, 713 F.2d 731 (Fed. Cir, 1986) (finding that prior art was deficient in at least one element); accord MPEP § 2143.03 (citing *In re Royka*, 490 F.2d 981 (CCPA 1974)).

Independent claims 1, 10, 28, and 37 are allowable because the cited references, alone or in combination, fail to teach or suggest all of the claimed limitations. Among other things, the references do not teach or suggest oak dust in any amount. Both Snogren and Strauss are cited in the Office Action for the teaching of ground cork or granulated cork in a silicone resin, and the Office Action asserts that these elements teach or suggest the oak dust component of Applicant's claimed invention. Applicants respectfully disagree with this assertion and submit that neither granulated cork nor ground cork teaches or suggests oak dust. Granulated and ground cork do not necessarily include a dust, and neither reference teaches or suggests the inclusion of a dust. Furthermore, as presented by Applicants in previous responses, the oak dust limitation is not taught or suggested by a reference disclosing natural cork.

The Examiner also cites the "oak chips and/or splinters" in Dewar against the feature of oak dust. Again, Applicants respectfully disagree with this assertion and submit that neither oak chips nor oak splinters teach or suggest oak dust. Oak chips and oak splinters are not dust, and the reference does not mention the inclusion of a dust. Furthermore, Dewar fails to teach or suggest that the oak chips and oak splinters do not consist of or comprise natural cork, as claimed in claims 28 and 37, respectively.

If the Examiner wishes to rely upon an inherency argument to state that oak dust is taught or suggested by Snogren, Strauss, or Dewar, Applicants remind the Examiner that a rationale or evidence must be provided tending to show inherency. *See* MPEP 2112. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the

inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993). The Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (Bd. Pat. App. & Inter. 1990). In the instant case, the teachings of Snogren, Strauss, and Dewar do not absolutely and necessarily teach a dust, let alone oak dust.

#### **Failure to Provide Articulated Reasoning**

The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007). But most, if not all, inventions arise from a combination of old elements. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000) (citing *In re Rouffet*, 149 F.3d at 1357). "Thus, every element of a claimed invention may often be found in the prior art" and the Examiner must consider the claimed invention as a whole. *Id.* at 1369-70; accord MPEP § 2141.02. "(I)dentification in the prior art of each individual par claimed is insufficient to defeat patentability of the whole claimed invention." *Kotzab*, 217 F.3d at 1370. The Examiner may not evaluate the invention "par by par," using the invention as a "roadmap to find its prior art components." *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005). Hindsight reconstruction is impermissible. *Rouffet*, 149 F.3d at 1357-58; *In re Fitch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

Moreover, an alleged reason for combining the teachings of the prior art must be supported by articulated reasoning with some "rational underpinning" to support the legal conclusion of obviousness. *See, KSR*, 127 S. Ct. at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Broad conclusory statements of suggestion or motivation standing alone are not sufficient. *Id.*

The Office Action concedes that the primary references do not disclose oak dust in the amount claimed. The Office Action relies on Snogren, Strauss, and Dewar to fill this void. Thus, even assuming, *arguendo*, that Snogren, Strauss, and Dewar teach all that is alleged, the Examiner must nonetheless demonstrate with articulated reasoning that a person having ordinary skill in the art would have an apparent reason to combine the teachings of Oka, Meguriya I, or

Meguriya II with the teachings of Snogren, Strauss, and Dewar such that the Applicants' claims as a whole are unpatentable. *See*, KSR, 127 S. Ct. at 1741. The Examiner has failed to satisfy this burden. *See* 35 U.S.C. § 132; MPEP §§ 2141, 2142, 706.020).

The references that the Examiner cites not only fail to teach or suggest all of the claimed limitations, as discussed above, but the Examiner merely provides broad conclusory statements regarding the apparent reason to combine the references in a manner that would render the claims obvious. The Office Action states that the "references represent art analogous in scope" such that "one having ordinary skill in the art would have a high level of expectation of success." The Examiner does not provide an articulated reasoning with rational underpinnings to explain how providing a silicone-based compound would motivate one to incorporate ground cork or oak dust from an ablative compound to arrive at a material that resembles natural cork in both appearance and physical properties. Moreover, the Examiner does not provide a rational connection between Dewar and the primary references. The Examiner states that Dewar "may include a silicone polymer with a filler of 'oak chips and/or splinters' to 'provide a rustic freckled appearance'," but this statement is misleading. Dewar teaches a wool or other fiber-based closure that may include wood chips or splinters. The reference only mentions silicone as being a possible coating for the closure. The wood chips are not added to the silicone and a person of ordinary skill in the art would have had no apparent reason for combining the teachings of Dewar with the primary references.

Consequently, the Examiner has failed to meet the burden of a *prima facie* case of obviousness under § 103, and the Applicants respectfully request that the rejection of claims 1-18 and 28-45 be withdrawn.

#### **Rebuttal of Examiner's Response**

Applicants hereby refer to arguments and evidence presented in previous responses to rebut the Examiner's arguments in the "Response to Arguments" portion of the Office Action dated April 7, 2008.

### CONCLUSION

Applicants respectfully submit that the pending claims 1-18 and 28-46 are in condition for allowance and such a Notice is respectfully requested. The Examiner is invited to call the undersigned at the below-listed telephone number if, in the opinion of the Examiner, such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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